

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: STONE et al.
Title: Secure tracking system and method for video program content
Appl. No.: 10/600,081
Filing Date: 6/20/2003
Examiner: Jeremy S. Duffield
Art Unit: 2427
Confirmation Number: 6842

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents
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Sir:

In accordance with the **Pre-Appeal Brief Conference Pilot Program**, announced July 11, 2005, this Pre-Appeal Brief Request is being filed together with a Notice of Appeal.

REMARKS

Claims 2, 4, 6-7, 10-14, 17-19, 24-27, 32-33, 36, 38, 40 and 42 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 7,020,304 to Alattar *et al.* (hereinafter “Alattar”) in view of U.S. Patent No. 7,289,304 to Brunk *et al.* (hereinafter “Brunk”). Claims 3, 15-16, 20-23, 28-31, 35 and 39 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Alattar and Brunk in view of one or more of the following references: U.S. Patent No. 6,912,010 to Baker *et al.* (hereinafter “Baker”), U.S. Patent Publication No. 2002/0054089 to Nicholas *et al.* (hereinafter “Nicholas”), U.S. Patent No. 6,785,815 to Serret-Avila *et al.* (hereinafter “Serret-Avila”), U.S. Patent No. 6,915,422 to Nakamura, and U.S. Patent No. 6,487,301 to Zhao.

Applicant respectfully disagrees with the Examiner's position and, therefore, traverses the Examiner's rejections for at least the reasons that follow.

In rejecting independent claims 2, 10 and 32 of the present application, the Examiner has relied on certain sections of Alattar and Brunk to assert that these references render the features of the pending claims obvious. However, in rejecting these claims, the Examiner appears to have overlooked Applicant's amendments filed on May 18, 2009, in response to the February 18, 2009, Office Action. In particular, Applicant amended claims 2, 10 and 32 to specifically recite that redundantly identifying the broadcast program comprises three separate operations:

- (1) comparing the detected watermark value with the database of registered watermark values;
- (2) if a detected watermark value matches a registered watermark value from said database of registered watermark values, cross-checking said fingerprint value derived from said given broadcast program against said database of registered fingerprints; and
- (3) if said derived fingerprint matches a registered fingerprint from said database of registered fingerprints, a first identification information associated with said registered watermark value is compared with a second identification information associated with said registered fingerprint.

As such, according to the currently pending claims, the redundant identification of a broadcast program is manifested not only through comparing the detected watermark value with data based of registered watermark value, but also in cross-checking the fingerprint value derived from broadcast program with a data base of registered fingerprints, as well as in comparing a first identification information associated with the registered watermark value with a second identification information associated with the registered fingerprint.

As described in Applicant's previous responses, the pending claims are, at a minimum, distinguishable from the disclosure of Alattar and Brunk in that these cited references fail to describe the operations identified by (1) and (2) above. In response, the Examiner is making two assertions. First, the Examiner is arguing that since Alattar and Brunk describe using content signatures and watermarks to carry certain information, it would have been obvious to a person of ordinary skill in the art to realize that the two may carry the same or very similar information to redundantly identify a content. See Office Action dated September 2, 2009, page 2, lines 7-23. Applicant respectfully disagrees.

According to MPEP § 2141.01:

“It is difficult but necessary that the decisionmaker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art.”

Even if, as alleged by the Examiner, the watermarks and content signatures that are described in Alatter and Brunk convey the same or similar information, there are no teachings or suggestions in these references to indicate the use of these watermarks and fingerprints in a manner that is recited in the pending claims. In particular, these references fail to teach or suggest detecting the watermarks, comparing the detected values to a database, if a match is found, cross-checking a derived fingerprint against a database of registered fingerprints.

In alleging disclosure in the prior art of the features of the pending claims related to operations (1) and (2) above, the Examiner is further arguing that Brunks describes that “a content signature can also be compared to digital watermark data and if the content signature and digital watermark data match (or otherwise coincide) the content is determined to be authentic.” See Office Action dated September 2, 2009, page 3, lines 6-7. Contrary to the Examiner’s assertions, the operations identified as (1) and (2) above do not merely recite comparing a content signature to a digital watermark. As noted in Applicant’s earlier responses, the “comparing” described in Brunk fails to properly operate and/or identify the proper content, if a content is modified in such that watermarks are missing from the content and/or the derived fingerprints falsely identify an incorrect version of the song. Rather, due to the redundant identification of the content based on the specific features that are recited the pending claims, each one of the above described example scenarios may still result in content identification. As such, the mere comparison of a content signature to a watermark value that is described in Brunk’s disclosure is significantly different from the features of the pending claims related to operations (1) and (2) above.

Thus, the features of the pending claims relating to operations (1) and (2) above are sufficiently novel and non-obvious over the prior art. Further, the pending claims recite an additional novel feature related to operation (3) above. Specifically, in accordance with the pending claims, once a watermark has been detected and matched against a database of registered watermarks and a fingerprint has been derived and matched against a database of

registered fingerprints, a first identification information associated with said registered watermark value is compared with a second identification information associated with said registered fingerprint. As such, the process of redundant identification, according to the pending claims, additionally comprises matching certain identification information associated with the watermarks with certain other identification information associated with the registered fingerprints. These additional features of the pending claims are not taught or suggested by Brunk, Alattar or any other references of record.

In alleging disclosure of this feature in the prior art, the Examiner is relying on Brunk's "comparing" of a content signature and a watermark value by further reasoning that "the fingerprint and the watermark may both contain the same information and when compared the information will coincide to prove the content to be authentic or will be different and prove the content to be modified in some way." See Office Action dated September 2, 2009, page 7, lines 1-9. Applicant respectfully disagrees. First, the Examiner is overlooking the fact that the above-noted feature of the pending claims, related to operation (3), is different from, and is performed in addition to, the features related to operations (1) and (2). However, the Examiner is using the same sentence from Brunk's disclosure to argue that Brunk describes redundant identification of a content according to operations (1) and (2), as well as operation (3). Such assertion is not supported by Brunk's disclosure and/or an understanding of a person of ordinary skill in the art, as the mere comparison of a watermark value to a content signature does not, in any way, teach or suggest all the various features that are recited in the pending claims.

Further, the comparison of a content signature to a watermark value is an entirely different operation than what is recited in operation (3), namely, comparing a first identification information associated with said registered watermark value with a second identification information associated with said registered fingerprint. The pending claims specifically recite a "[derived] fingerprint," a "registered fingerprint," a "registered watermark value," a "first identification information" and a "second identification information." The above-noted section of Brunk's description merely describes the comparison of two values (i.e., a watermark value and a content signature), which cannot be construed as teaching or suggesting the interactions between the at least five values that are recited in the pending claims.

In addition, unlike the redundant monitoring that is effected according to the pending claims, Brunk's comparison of the content signature and a watermark value fails to properly operate and/or identify the proper content, if a content is modified in each of the following four example scenarios: A) watermarks are missing from the content, B) fingerprints are not detected in the database, C) watermarks are mis-decoded so that they identify a wrong content owner, and/or D) derived fingerprints falsely identify an incorrect version of the song. In contrast, due to the redundant identification of the content based on the specific features recited in the pending claims, and further described, for example, in Figure 4 and at pages 13-17 of the originally filed specification, each one of the above described example scenarios may still result in content identification.

Therefore, Brunk and Alattar, either alone or in combination, fail to teach or suggest at least the above-noted features of claims 2, 10 and 32. Accordingly, claims 2, 10 and 32 are patentable.

Dependent claims 3-4, 6-7, 12-31, 33, 35-36, 38-40 and 42 each depend, either directly or indirectly, from one of allowable claims 2, 10 or 32. Further, Nicholas, Serret-Avila, Nakamura and/or Zhoa fail to cure the above-noted deficiencies of Alattar and Brunk. Accordingly, claims 3-4, 6-7, 12-31, 33, 35-36, 38-40 and 42 are patentable for at least that reason, as well as for other patentable features when these claims are considered as a whole.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application is respectfully requested.

Respectfully submitted,

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